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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Application No. Applicant(s) 10/617,904 BHANDARKAR ET AL. Office Action Summary Examiner Art Unit PAUL R. FISHER 3689 -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS. WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status 1) Responsive to communication(s) filed on 31 March 2008. 2a) This action is FINAL. 2b) This action is non-final. 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) Claim(s) 1.3-8.10.12-15 and 17-24 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. 5) Claim(s) _____ is/are allowed. 6) Claim(s) 1,3-8,10,12-15 and 17-24 is/are rejected. 7) Claim(s) _____ is/are objected to. 8) Claim(s) _____ are subject to restriction and/or election requirement. Application Papers 9) The specification is objected to by the Examiner. 10) ☐ The drawing(s) filed on 11 July 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. Attachment(s) 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)

Notice of Draftsperson's Patent Drawing Review (PTO-948)

Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _______

Paper No(s)/Mail Date.

6) Other:

Notice of Informal Patent Application

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DETAILED ACTION

Amendment received on March 31, 2008 has been acknowledged. Claims 2, 9,
 and 16 have been canceled, Claim 24 has been added. Claims 1, 3-8, 10, 12-15, 17-24 are currently pending and have been considered below.

Claim Objections

2. Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 18 is to a computer readable medium that stores the executable instructions for performing the method and fail to limit that method further.

Claim Rejections - 35 USC § 112

- 3. The following is a quotation of the first paragraph of 35 U.S.C. 112:
 - The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pretains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
- 4. Claims 1, 3-8, 10, 12-15, 17-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new limitation of "automatically and without user intervention" are considered to be new matter since no

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support for this limitation can be found in the applicants specification. The applicant has relied on paragraphs 20 and 21 for these new limitations stating that it is "inherently carried out" but the Examiner can find no such support. In paragraph 20 it is stated that the selection criteria would result in the choosing of the cheapest supplier but it is not stated that the program is making this selection, the selection could just as easily be made by a user. In paragraph 21 it is stated that upon updating the information the new cheapest supplier would be chosen again it does not state that this would be automatic nor does it state that the program would be choosing it, the selection could be done by a user, since it does not state that a user can not do this part. In paragraph 19 it states that the program is instructed to select not that it directly selects a supplier and again at no point does it say a user can not do this or that it is done automatically.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claims 1-23, the method and system claimed is non-statutory because it fails to physically transform the information being stored to generate tangible results. Claims 1-10, CLAIM a business process execution engine which is not disclosed in the claims or the specification to be tangible and the method of using the engine fails to produce a tangible result thus it is an arrangement of data. Since it is a mere arrangement of data it is therefore nonfunctional descriptive

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material, which is nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759.

Claim Rejections - 35 USC § 103

- The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- Claims 1, 3, 4, 6, 7, 10, 12, 13, 14, 15, 17,18-22, and 24 are rejected under 35
 U.S.C. 103(a) as being unpatentable over Dworkin (4,992,940), in view of Rossides (5,359,508).

As per claims 1 and 18, Dworkin discloses at a business process execution engine, a computer implemented method and software for dynamically managing business partners in a system that includes a business process application and without requiring the business process application to be modified or recompiled (Col. 3, lines 48-59; discloses that the program is made to search a database of information regarding products to find the lowest price while still meeting the minimum requirements. Col. 3, line 60 thru Col. 4, line 2; discloses that the system is implemented through the use of a computer), the method comprising:

the business process execution engine accessing a compiled business process application that includes selection criteria for selecting business partners, the selection criteria indicating attributes that a business partner is to include to match the selection criteria (Col. 3. lines 48-50; discloses that the user can use the system to search

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through various vendors or suppliers, which are business partners, to select the one which best fits both their minimum product requirements and lowest price);

the business process execution engine accessing business partner attributes for a plurality of business partners, each business partner including at least one attribute (Figure 7; discloses that each vendor or supplier has various attributes which include name, state, payment types accepted and price);

Dworkin discloses a business process execution engine utilizing the selection criteria to match the selection criteria such that the business partner is selected (Col. 6, lines 26-37; disclose that each product has a lowest price associated with it denoting the vendor who has the lowest price for that item).

Dworkin further discloses updating an attribute of a second business partner to match the selection criteria subsequent to selecting the first business partner, wherein the attribute update is made without modifying the compiled business process application (Col. 6, lines 26-37, specifically lines 32-35; disclose that every search these values for lowest price will be recalculated since the database is search each time. Col. 10, lines 46-53; discloses that information regarding the products can be updated either by the system operator or the vendors or suppliers themselves this would allow the suppliers to update their prices so upon the next search the updated prices would become visible, all of this is done through the updating of the database not through the recompiling or modifying of the searching program);

Dworkin fails to explicitly disclose the business process execution engine utilizing the selection criteria to automatically and with out user intervention select a first

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business partner with an attribute that matches the selection criteria such that the first business partner is selected by the business process execution engine and not by a user;

the business process execution engine utilizing the selection criteria and the updated attribute to automatically and without user intervention select the second business partner such that the second business partner is selected by the business process execution engine and not by the user.

Rossides, which talks about a database program for finding the lowest price for a desired product, teaches utilizing the selection criteria to automatically and with out user intervention select a first business partner with an attribute that matches the selection criteria such that the first business partner is selected by the business process execution engine and not by the a user (Figure 2; discloses a system where the product name or selection criteria is entered and then without user involvement the lowest price is found and that supplier is automatically selected. Col. 9, lines 21-30; disclose that the LPL or lowest price locator is used to find the list of stores and prices associated with the product name it finds the store with the lowest price and that store is automatically selected);

Rossides, further teaches that the business process execution engine utilizing the selection criteria and the updated attribute to automatically and without user intervention select the second business partner such that the second business partner is selected by the business process execution engine and not by the user (Figure 2; discloses a system where the product name or selection criteria is entered and then

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without user involvement the lowest price is found and that supplier is automatically selected. Col. 9, lines 21-30; disclose that the LPL or lowest price locator is used to find the list of stores and prices associated with the product name it finds the store with the lowest price and that store is automatically selected, from this it is shown that the database would be run again and this time the updated information would be used if a lower price is found that price would be used since the purpose of the system is to find the lowest possible price for a product).

Therefore, from this teaching of Rossides, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the automated selection of equipment for purchase through input of user provided by Dworkin, with the automatic selection of a supplier based on lowest price taught by Rossides, for the purpose of providing the user with the lowest price for their desired product. Dworkin already shows that the system calculates the lowest price and the average price based on the information stored in the database and does this for every search to ensure that the information is updated. It would have been obvious to use the automatic supplier selection based on lowest price taught by Rossides to achieve the goal of arriving at the lowest cost as set forth in Dworkin.

As per claim 3, Dworkin discloses wherein the at least one attribute comprises identifying information (Figure 7; discloses that the user can see information on the supplies such as supplier name, where the partner is construed to be the supplier).

As per claim 4, Dworkin discloses wherein the at least one attribute comprises selection information (Figure 8; discloses the information based on the selection

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including the product manufacturer, model number, type, speed, and comments about the selection).

As per claim 6, Dworkin discloses wherein the at least one attribute comprises custom business partner data (Figure 7; discloses that the user can see custom information on the supplier under the field of comments of the supplier as well as the supplier name and supplier number).

As per claim 7, Dworkin discloses different document formats (Col. 4, lines 21-24; discloses that the user can place an order using mail, electronic mail, and facsimile). It is old and well known in the art at the time of then invention to identify a preferred document format if the vendor has a specific way they would like to receive the purchase order. Since the invention disclosed by Dworkin has the ability to display and identify custom pieces of information from the vendor (Figure 7; discloses the comments of the supplier where the supplier could display the request for a specific preferred document format) it would be obvious to display a request for a specific document format.

As per claim 10, Dworkin discloses while running the business process application, binding instances of a business partner variable to the partner (Col. 8, lines 30-33; discloses that each order is provided with a transaction number which binds the instance of the search in this case a particular product sold by a particular vendor for a set price with a number that will allow both the vendor and the user access to the information on the exact order).

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As per claim 12, Dworkin discloses adding an additional business partner to the plurality of business partners (Col. 10, lines 46-53; discloses that the operator of the system can update all of the information regarding the information stored in the database which would entail the management of business partners which are construed to be suppliers. This management would include the addition of new suppliers).

As per claim 13, Dworkin discloses deleting a business partner from the plurality of business partners (Col. 10, lines 46-53; discloses that the operator of the system can update all of the information regarding the information stored in the database which would entail the management of business partners which are construed to be suppliers. This management would inherently include the deletion of new suppliers).

As per claim 14, Dworkin discloses wherein the adding or deleting is performed by a business partner (Col. 10, lines 46-53; discloses that the operator of the system or the suppliers themselves can update all of the information regarding the information stored in the database which would entail the management of business partners which are construed to be suppliers. This would include modifying the attributes of business partners).

As per claim 15, Dworkin discloses wherein the update is provided by a business partner (Col. 10, lines 46-53; discloses that the system can also be programmed to allow direct access, by suppliers, to the database, so that the suppliers themselves can update their information whenever necessary).

As per claim 17, Dworkin discloses wherein the at least one attribute comprises price information (Figure 7; discloses that each supplier has a set price for each item

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being sold, Col. 10, lines 46-53; discloses that each supplier would be able to modify their own information which would include the prices of their products).

As per claim 19, Dworkin discloses a computer implemented system for performing a business process (Abstract; discloses that the system includes a programmed computer that interfaces with a database that contains a large number of different products and/or services, arranged in various categories, the object of this program is to select a vendor selling the desired product based on the criteria selected by the user), the system comprising:

a computer readable storage medium containing a containing a compiled business process application that includes selection criteria for selection business partners, the selection criteria indicating attributes that a business partner is to include to match the selection criteria (Col. 5, lines 35-50; discloses that the program is programmed to aid the using in selecting a product when the user selects a type of product a template is shown to the user to aid them in filling is selection criteria, upon entering the selection criteria different suppliers are provided and the user can select the supplier based on additional information contained in the system):

a computer readable storage medium containing business partners attributes for a plurality of business partners, each business partner including at least one attribute (Col. 6, lines 32-35; discloses that the database stores all the possible vendors and the prices of their products. Figure 7; discloses the attributes that are stored about each supplier in the system); and

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a business process execution engine that performs a method for dynamically managing business partners in the system without requiring the business process application to be modified or recompiled (Col. 6, lines 32-35; discloses that based on the users selected item the database is searched and displays all of the vendors and their prices for the associated product), the method comprising:

accessing the compiled business process application (Col. 4, lines 35-44; disclose loaging into or accessing the system);

accessing the business partner attributes (Col. 4, lines 53-54; disclose obtaining or accessing the business partner or vendor attributes):

utilizing the selection criteria to select a first business partner with an attribute that matches the selection criteria such that the first business partner is selected by the business process execution engine (Col. 6, lines 26-37; disclose that each product has a lowest price associated with it denoting the vendor who has the lowest price for that item);

subsequent to an update to the business partner attributes and subsequent to selecting the first business partner, wherein the update corresponds to an attribute of a second business partner, and the update is made without modifying the compiled business process application, utilizing the selection criteria and the updated attribute to select the second business partner (Col. 6, lines 26-37, specifically lines 32-35; disclose that every search these values for lowest price will be recalculated since the database is search each time. Col. 10, lines 46-53; discloses that information regarding the products can be updated either by the system operator or the vendors or suppliers themselves

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this would allow the suppliers to update their prices so upon the next search the updated prices would become visible, all of this is done through the updating of the database not through the recompiling or modifying of the searching program);

Dworkin fails to explicitly disclose wherein the selection of the business partner is done automatically and without user intervention.

Rossides, which talks about a database program for finding the lowest price for a desired product, teaches utilizing the selection criteria to automatically and with out user intervention select a first business partner with an attribute that matches the selection criteria such that the first business partner is selected by the business process execution engine and not by the a user (Figure 2; discloses a system where the product name or selection criteria is entered and then without user involvement the lowest price is found and that supplier is automatically selected. Col. 9, lines 21-30; disclose that the LPL or lowest price locator is used to find the list of stores and prices associated with the product name it finds the store with the lowest price and that store is automatically selected);

Rossides, further teaches that the business process execution engine utilizing the selection criteria and the updated attribute to automatically and without user intervention select the second business partner such that the second business partner is selected by the business process execution engine and not by the user (Figure 2; discloses a system where the product name or selection criteria is entered and then without user involvement the lowest price is found and that supplier is automatically selected. Col. 9, lines 21-30; disclose that the LPL or lowest price locator is used to find

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the list of stores and prices associated with the product name it finds the store with the lowest price and that store is automatically selected, from this it is shown that the database would be run again and this time the updated information would be used if a lower price is found that price would be used since the purpose of the system is to find the lowest possible price for a product).

Therefore, from this teaching of Rossides, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the automated selection of equipment for purchase through input of user provided by Dworkin, with the automatic selection of a supplier based on lowest price taught by Rossides, for the purpose of providing the user with the lowest price for their desired product. Dworkin already shows that the system calculates the lowest price and the average price based on the information stored in the database and does this for every search to ensure that the information is updated. It would have been obvious to use the automatic supplier selection based on lowest price taught by Rossides to achieve the goal of arriving at the lowest cost as set forth in Dworkin.

As per claim 20, Dworkin discloses wherein the at least one attribute comprises contact information (Col. 4, lines 21-24; disclose that the system will contact the supplier showing that the system stores the contact information of the supplier, where the partner is construed to be the supplier).

As per claim 21, Dworkin discloses wherein the at least one attribute comprises price information (Figure 7; discloses that each supplier has a set price for each item being sold).

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As per claim 22, Dworkin discloses different document formats (Col. 4, lines 21-24; discloses that the user can place an order using mail, electronic mail, and facsimile). It is old and well known in the art at the time of then invention to identify a preferred document format if the vendor has a specific way they would like to receive the purchase order. Since the invention disclosed by Dworkin has the ability to display and identify custom pieces of information from the vendor (Figure 7; discloses the comments of the supplier where the supplier could display the request for a specific preferred document format) it would be obvious to display a request for a specific document format

As per claim 24, Dworkin discloses wherein the compiled business process application is an executable file that is executed by the business process execution engine (an executable file is defined as a computer file containing a program that is ready to be run or be carried out; "executable file." Webster's New Millennium™ Dictionary of English, Preview Edition (v 0.9.7). Lexico Publishing Group, LLC. 05 Jul. 2008. <Dictionary.com https://dictionary.reference.com/browse/executable file>. Col. 4, lines 30-44; disclose that the file is a computer file and it is executed from the definition of an executable file the program being run in Dworkin is an executable file as are all computer programs that are run).

 Claims 5, 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin (4,992,940), in view of Singh (US2001/0047311A1).

As per claim 5, the combination Dworkin and Rossides teaches the aboveenclosed invention, but fails to disclose the use of digital certificates.

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Singh, which talks about a method for communicating, collaborating and transacting commerce via a communication network, teaches wherein the at least one attribute comprises a digital certificate (Paragraph 0041; teaches that for security reasons buyers and suppliers will log on to the site and post orders while providing a digital certificate to ensure that user is valid).

From this teaching of Singh, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system for finding a supplier of a product provided by the combination of Dworkin and Rossides with the use of digital certificates taught by Singh, for the purpose of ensuring that the users of the system are valid and that the transactions safe.

As per claim 8, Dworkin discloses different document formats (Col. 4, lines 21-24; discloses that the user can place an order using mail, electronic mail, and facsimile). It is old and well known in the art at the time of then invention to identify a preferred document format if the vendor has a specific way they would like to receive the purchase order. Since the invention disclosed by Dworkin has the ability to display and identify custom pieces of information from the vendor (Figure 7; discloses the comments of the supplier where the supplier could display the request for a specific preferred document format) it would be obvious to display a request for a specific document format.

Dworkin fails to disclose where the document format comprises an extensible markup language schema also known as XML.

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Singh, which talks about a method for communicating, collaborating and transacting commerce via a communication network, teaches wherein the document format comprises an extensible markup language schema (Paragraph 0043; teaches that the data can be formatted according to an internet protocol-compliant language such as HTML or XML or the like).

From this teaching of Singh, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system for finding a supplier of a product provided by the combination of Dworkin and Rossides with the use of XML formatting taught by Singh, for the purpose of providing the user a web based alternative to mail or e mail. The use of XML and HTML for the purposes of ordering products online became more widely used after the time of the Dworkin invention and would be an obvious improvement to the system.

As per claim 23, Dworkin discloses different document formats (Col. 4, lines 21-24; discloses that the user can place an order using mail, electronic mail, and facsimile). It is old and well known in the art at the time of then invention to identify a preferred document format if the vendor has a specific way they would like to receive the purchase order. Since the invention disclosed by Dworkin has the ability to display and identify custom pieces of information from the vendor (Figure 7; discloses the comments of the supplier where the supplier could display the request for a specific preferred document format) it would be obvious to display a request for a specific document format.

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Dworkin fails to disclose where the document format comprises an extensible markup language schema also known as XML.

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From this teaching of Singh, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system for finding a supplier of a product provided by the combination Dworkin and Rossides with the use of XML formatting taught by Singh, for the purpose of providing the user a web based alternative to mail or e mail. The use of XML and HTML for the purposes of ordering products online became more widely used after the time of the Dworkin invention and would be an obvious improvement to the system.

Response to Arguments

 Applicant's arguments filed March 31, 2008 have been fully considered but they are not persuasive.

Rejection under 35 USC § 101

10. As per the applicant's argument that the claimed invention produces a tangible result, the Examiner respectfully disagrees as currently claimed the invention produces no result but simply search a database and makes a selection. The selection itself is not

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considered to be a tangible result since it is not used it is simply just a piece of data which is subject to change based on the other updating of other data also being stored. At no point is the user making use of this selection by ordering or purchasing a product. Since there is no transformation or transaction occurring, the data is still just being stored and is not considered to be tangible.

Rejection under 35 USC §102

 Applicant's arguments with respect to claims 1, 18 and 19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

 Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL R. FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [7:30am/5pm] with first Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PRF /Janice A. Mooneyham/ Supervisory Patent Examiner, Art Unit 3689 Art Unit: 3689